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10/806,663	03/18/2004	Yaron Mayer		1166

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EXAMINER	
SHAH, AMEE A	
ART UNIT	PAPER NUMBER
3625	
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09/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/806,663	MAYER, YARON	
	Examiner	Art Unit	
	Amee A. Shah	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 22-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 22-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1 and 22-42 are pending in this action.

Response to Amendment

Applicant's amendment, filed July 2, 2007, has been entered. Claims 1, 22-24, 26, 27, 33, 34, 38 and 39 have been amended. Claims 2-21 have been cancelled.

In view of the amended drawings, the objections to the drawings are withdrawn. In view of the amended specification, the objections regarding trademark use are withdrawn; however the objections regarding hyperlinks remain.

In view of the amendments to the claims, the 35 U.S.C. §112 regarding "at least one of" and trademark usage are withdrawn. However, other §112 rejections remain and new ones are necessitated by the amendments.

The examiner also notes that while applicant indicated amendments to the claims were submitted August 9, 2004, those amendments have not been entered into the folder, and the Examiner does not have any copies of them. If the applicant wishes to have those amendments entered, it is advised that the claims be resubmitted.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless

the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. *See* MPEP § 608.01. The Examiner notes applicant's attempt to remove the hyperlink by removing "http://." However, this is not sufficient, particularly because the text will show as hyperlinks and in fact are locations on the Internet for the documents cited.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-42 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

Claims 1 and 22-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 1 and 22 recite, in part, multiple uses of "and/or." This term "and/or" is prevalent throughout all the claims and is interpreted in the alternative, i.e. an "or." The claims do not clearly set forth the metes and bounds of the patent

protection desired. *See* MPEP § 2173.05(c). For example, in claims 1, is the invention a system for searching multiple sites for prices and other data and for obtaining results and on a server or is the system for searching multiple sites or obtaining results and resident on a user's computer? For purposes of this action only, the Examiner will interpret the claims in the manner indicated below. Because claims 23-42 are dependent on claim 22, they inherit the same deficiencies, are rejected on the same bases, and are interpreted in the same manner.

Claims 26, 27 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 25 lists alternative features for the method of claim 22. Prior art need only disclose one of these alternative features. The alternate features render claims 26, 27 and 34 indefinite sine it is unclear to one of ordinary skill in the art the scope of the claims if the features disclosed in claims 26, 27 and 34, i.e. the features of criteria for deciding if to order some of the items directly or not and of criteria for deciding when to offer the user aggregating services, are not the chosen features. Applicant's specification does not preclude the features not being present. Therefore, the limitations of claims 26, 27 and 34 will not be considered in the analysis of the claims.

Examiner Notes

1. Applicant uses the term "heuristics" in the claims. Merriam-Webster defines this term as "involving or serving as an aid to learning, discovery, or problem-solving by experimental and especially trial and error methods," (Merriam-Webster's Collegiate Dictionary, 10th ed., 1997).

Thus, the Examiner interprets "heuristic" as involving any method serving as an aid to problem-solving such as by experimentation.

2. Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> > (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 22-29, 31 and 33-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Alexander, US 2002/0178014 A1 (hereafter referred to as "Alexander").

Referring to claims 1 and 22. Alexander discloses a system and method for automatic optimization of orders of multiple items from multiple sources, which takes into account at least the item prices and the shipment prices, and generates at least one acceptable or near-optimal offer which is not necessarily the optimal solution, comprising a first system or first means for

searching multiple vendor sites for prices and other relevant data or for obtaining results from one or more servers capable of searching said sites, wherein the system or means are on a server or the user's computer, and a second system or means for executing the computations needed for finding said at least one acceptable offer wherein said second system or means are on a server or the user's computer and is couples to the first system or means and receives input from the first system or means (at least Abstract, Fig. 1 and ¶¶0004, 0005, 0009 and 0010 – note that Alexander discloses that is old and well-known in the art to use servers and/or programs to search multiple vendor sites for price data and Alexander discloses a program/system capable of using this data to perform the necessary computations to find at least one acceptable offer, i.e. and optimal shopping order).

Referring to claim 23. Alexander discloses further discloses the method of claim 22 wherein said at least one acceptable or near-optimal offer is defined by being within an acceptable maximum deviation from at least one lower boundary or theoretical optimum, and said lower boundary is determined by at least one of taking the lowest price available for each item and the shipment price if all of the items were available from the shop with the lowest shipment prices or heuristic estimates (at least Fig. 1 and ¶¶0017-0019 – note the optimal shopping order is within the acceptable boundaries identified by the user and can be the lowest price with shipping from one vendor with all of the items).

Referring to claim 24. Alexander discloses the method of claim 23 wherein said maximum allowed deviation is determined by at least one of the system and the user and

according to at least one of: the distance between the lower bound and the upper bound; automatic adjustment according to the time limit set by the user; automatic adjustment according to progress over time; statistics of similar past cases and/or statistics and/or parameters and/or characteristics of the current case; heuristics; the user's response to the deviation recommended by the system; or if the results have been obtained after too little time the system tries again with a lower deviation (¶¶0017-0020 – note that the maximum allowed deviation is determined by the system and/or the user and according to statistics/parameters of the current case with other cases, i.e. total price must be X% or $Y less than other vendors' prices).

Referring to claims 25-27 and 34. Alexander further discloses the method of claim 22 wherein at least one of the following features exists: said system is based on results from price comparison metasearch from multiple online vendors or shops (¶0016 – note that since the system includes the feature of using results from price comparison metasearch from multiple vendors and online shops, claims 26, 27 and 34 do not apply).

Referring to claim 28. Alexander further discloses the method of claim 22 wherein the method takes into consideration also rules for preferring and/or avoiding certain vendors which are at least one of: absolute, or dependant on at least one condition that relates to the order (¶0017).

Referring to claim 29. Alexander further discloses the method of claim 22 wherein after getting the at least one acceptable or near-optimal offer, the user can either make the order

automatically through the meta-search site, or purchase the grouped items directly at the recommended stores, if he so prefers (¶0022).

Referring to claim 31. Alexander further discloses the system of claim 23 wherein the user can specify the maximum deviation from said lower bound or theoretical optimum; one or more maximum search time limits (¶¶0017 and 0020 – note that the system allows the user to specify the maximum deviation from the lower bound by specifying a total price that must be met).

Referring to claim 33. Alexander discloses the method of claim 23 wherein the server can automatically choose if to make the computation itself or to transfer it to the user's computer, according to at least one of: the number of items, the number of relevant vendors, the estimated complexity, the time limit that the user agrees to, the current load on the server, and the maximum allowed deviation that the user agrees to (¶0020 – note that the optimization can be performed by the server computer itself).

Referring to claim 35. Alexander further discloses the method of claim 22 wherein the system can automatically negotiate a better deal with at least some of the suppliers and/or make reductions automatically according to pre-agreed rules with those vendors (¶0018 – note that the system automatically makes reductions according to pre-agreed rules with the vendors by considering special offers by vendors).

Referring to claim 36. Alexander further discloses the method of claim 35 wherein said automatic negotiations or automatic reductions are performed at least one of: during the optimization process, or after one or more acceptable solutions have been generated (¶0018).

Referring to claim 37. Alexander further discloses the system of claim 29 wherein the transfer of orders from the system's site to the individual vendors can be done by at least one of: keeping a user profile and accessing automatically a shopping cart on behalf of the user on the individual vendor's site; billing the user directly and accessing the vendor's shopping cart with the system's site's billing info; through one or more special agreed protocols for faster transferring of orders from the system's site to the vendor without having to waste time on emulating a user clicking on various options or building up a shopping cart and checking out, or giving the vendor at least one of: the user's address, the system's address, and the address of an intermediary needed for aggregation (¶0022 – note that Alexander discloses it is old and well known in the art to transfer orders to the vendors by at least one of the ways suggested).

Referring to claim 38. Alexander further discloses the method claim 23 wherein if an acceptable result is not achieved within the specified time limit, then the system decides automatically or recommends to the user if to continue the attempts for additional time and/or to increase the maximum allowed deviation and try again, or to accept the result (¶0020).

Referring to claim 39. Alexander further discloses the method of claim 23 wherein the system decides which heuristics to use depending on various parameters and/or statistics

(¶¶0017-0019 – note the various parameters and/or statistics are the user-defined ones and the fixed criteria).

Referring to claim 40. Alexander further discloses the method of claim 23 wherein when showing the results the system shows the user also at least one of a summary of how close a given offer is to at least one of the lower bound and the upper bound, an estimate of how close a given offer it is to the actual optimum, and the effect of the speed of shipment on the price (¶0021 – note the information is shown in the optimal shopping order displayed to the user).

Referring to claim 41. Alexander further discloses the method of claim 22 wherein the user can request that the system will notify him automatically when some other condition becomes fulfilled (¶0020 – note the other condition is when an optimal shopping order exists).

Referring to claim 42. Alexander discloses the method of claim 41 wherein in order to find out when the conditions have been fulfilled, the system keeps a list of such requests and of the users who requested them, and then the system can find out when any of these items become available at the requested prices and/or other conditions become fulfilled by at least one of the following ways: running periodically special checks for the requested items, checking for the relevant items or conditions while updating periodically the prices, or noticing the relevant items whenever they come up in metasearches conducted by any users (¶0020 – note that in order to notify the user later, the system inherently keeps a list of the requests and that the system runs periodic special checks for the items).

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander in view of Loveland, US 2001/0027404 A1 (hereafter referred to as "Loveland").

Referring to claim 30. Alexander discloses the method of claim 22, as discussed above, wherein the system takes into consideration user preferences such as specific shops when computing the optimizations (¶¶0017-0020), but does not specifically disclose the system taking into consideration the user's indication of the acceptable distance of shops from which the user would personally pick up the item. Loveland, in the same field of endeavor and/or pertaining to the same issue, discloses a system and method for allowing users to purchase items wherein prices from several vendors may be compared and users may select vendors by geographical area so that the local vendors are the vendors selected for comparison (Fig. 4 and ¶0041).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Alexander to include the teachings of Lovelace to allow for the user preferences to include selection of local vendors from whom the user can pick up merchandise so that the system takes into consideration that user preference when computing the optimizations. One of ordinary skill in the art would have been motivated to do so based on the

knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would allow user's to search and optimize prices based on preferences more indicative of their actual desires, thereby increasing customer satisfaction.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander in view of Official Notice, as admitted by applicant to be prior art.

Referring to claim 32. Alexander discloses the system of claim 22, as discussed above, wherein the user can specify preferences and modify preferences when it modifies the optimal shopping order (¶¶0017 and 0021), but does not explicitly discloses the system saving various such user preferences in its own database and/or on the user's own computer for future searches. However, it was old and well known at the time of the invention for systems to save user preferences for searches, as admitted by applicant to be prior art. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would save a user time in not having to repeatedly entering his preferences when repeatedly using a search engine.

Response to Arguments

Applicant's arguments filed July 2, 2007, have been fully considered but they are not persuasive.

In response to the arguments regarding the objections to the specification for hyperlinks (Remarks, pages 14 and 15), the Examiner directs applicant's attention to MPEP §608.01 requiring there be no hyperlinks in the specification.

Regarding the amendments to claims 26, 27 and 34 (Remarks, page 15), while these claims do claim that the chosen feature exists, because they depend on claim 25, if that feature were not chosen, the claims would not exist. Thus, the 35 U.S.C. §112 rejections remain and the claims were not relevant since that feature of claim 25 was not chosen.

Regarding the argument that Alexander does not teach generating non-optimal solutions because the exact words "acceptable maximum deviation" or "acceptable boundaries" does not appear in the prior art (Remarks, page 16), the Examiner responds as follows. The features upon which applicant relies (i.e., generating non-optimal solutions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claims 1 and 22 recite in the preamble the system is capable of generating acceptable or near-optimal offers not necessarily the optimal solution. First, while the offer may "not necessarily" be optimal, there is no preclusion to it being optimal. Furthermore, these recitations are in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Second, it is not required that the prior art use the same exact words as applicant's claims, so long as the prior art shows structural or functional equivalence of the exact words of the claims (see, e.g., MPEP §2105). As explained above, Alexander does show these limitations.

Regarding applicant's argument that applicant should be afforded a patent because applicant's invention is more sophisticated than that of Alexander and since he received a patent, so should applicant (Remarks, page 16), Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The Examiner further notes that applicant did not traverse the factual assertion of claim 32 regarding official notice, because applicant did not specifically point out the supposed errors, including why the notices fact is not considered to be common knowledge or well-known in the art. Thus, the assertion that it is old and well known at the time of the invention for systems to save user preferences for searches is taken to be admitted prior art because the application failed to traverse the assertion. See MPEP §2144.03(C).

Conclusion

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site http://www.uspto.gov in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

September 4, 2007

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